

REMARKS

This responds to the Office Action mailed on March 23, 2006, and the references cited therewith.

Claims 1, 20 and 34 are amended; claims 1-47 are now pending in this application.

Correspondence Address

A Notification of Change of Correspondence Address, requesting correspondence be sent to Customer No. 49845, was filed with the U.S. Patent Office on June 8, 2005. Applicants request that all future correspondence for this application be directed to Applicants' attorneys as follows:

Schwegman, Lundberg, Woessner & Kluth, P.A.
P.O. Box 2938
Minneapolis, MN 55402
Telephone No. (612) 373-6900
Customer No. 49845

§101 Rejection of the Claims

Claims 1-19 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

The Office Action rejected claims 1-19 as being directed to the manipulation of an abstract idea that has no apparent concrete result as receiving the transaction request, matching the transaction request with property profiles and providing a transaction request do not result in an actual transformation of information or the performance of an actual transaction.

With respect to claim 1, and claims 2-19 which depend from claim 1, at least one transaction request is received from at least one *requesting party*, the at least one transaction request is matched with property profiles previously provided by the at least one *responsible party*, and the at least one transaction request is provided to the *responsible parties* having a matched property profile. Accordingly, in the method of claim 1 results in a transaction request being provided to responsible parties having property profiles that matched, such a provision being a useful, concrete and tangible result. Accordingly, Applicants respectfully request that the §101 rejection be withdrawn.

§112 Rejection of the Claims

Claims 1-47 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement. Applicants respectfully traverse this rejection.

The Action rejected “transaction request” as not being enabled by the specification because “there is no description in the specification of a ‘transaction request’ or how it is used in the applicant’s invention.”

On page 2, in paragraph 6, the current application publication states:

“A system and method for facilitating renting and purchasing relationships. The method includes receiving at least one property profile from at least one responsible party. At least one *transaction request* from each of a plurality of responsible parties is received. The *transaction requests* are matched with the property profiles. The *transaction requests* are provided to the responsible parties of those properties that match the *transaction request*. In one embodiment, an offer received from at least one of the responsible parties is provided to at least one of the requesting parties. The method may be executed on a computer connected to a network such as the Internet.” (Emphasis added).

Further, on page 4, in paragraph 12, the current application publication provides the following examples of transaction requests:

“In the following description, certain terminology is used to discuss features of the present invention. For example, the term ‘property owner’ is intended to refer to any person, group of persons, or entity that is seeking rental or sale of a property in part or whole. Such a person or entity may be denoted a ‘responsible party’ as it is this person, group of persons, or entity that is responsible for the renting or sale of the property. The property may include real property such as an apartment building, an apartment, a condominium building, a condominium unit, a cooperative building, a cooperative unit, a single family dwelling, a multi-family dwelling, a commercial building, and the like, and may also include personal property such as consumer merchandise and the like. The term ‘renter’ is intended to refer to any person, group of people, business or any other entity that is interested in renting or perhaps purchasing an interest in the property. The interest may be 100% denoting a sale of the property in its entirety. According to the present invention, a renter or purchaser may be denoted a ‘requesting party’ as it is the prospective renter's or purchaser's *initial rental or purchase request* that sets in motion events that may lead to a resulting transaction.” (Emphasis added).

Finally, on page 5, in paragraph 51, the current application publication also provides further examples:

“Referring still to FIG. 1, the *transaction center system* receives a renter profile and *rental request information* from *renters*, as shown in block 4. The “renter profile” may include a renter's name, email address, current home address, telephone number, etc. The ‘rental request’ may include information describing desired features and amenities of a rental unit, including: a monthly rent; either in a range or an exact amount that may be a maximum rent; a lease start date; a location such as in cross streets, town names, zip code, area code or other geographical designation; number of bedrooms; size of the unit in square feet or other measurement; and number of bathrooms. The rental request may also include more detailed information about a desired unit, such as specifying that the unit has or does not have a plurality of features, such as, for example whether the unit is furnished; is cable-ready; has a balcony, a deck, a patio, a yard, a washer and a dryer, washer and dryer hook-ups, an intrusion alarm, air conditioning, a ceiling fan, a refrigerator, a dishwasher, a garbage disposal, a microwave, hardwood floors, carpeting, a fireplace, walk-in closets, vaulted ceilings, high speed Internet access, etc.” (Emphasis added).

Someone of skill in the art would understand that rental requests and purchase requests as described in the specification are examples of two types of transaction requests. Since use of the term “transaction request” is enabled by the specification, Applicants respectfully request that the §112 rejection be withdrawn.

§102 Rejection of the Claims

Claims 1, 3-10, 12-14, 17-20, 22-25, 27-28, 31-42 and 44-47 were rejected under 35 U.S.C. § 102(e) for anticipation by Broerman (U.S. 6,594,633).

Applicants do not admit that Broerman is prior art, and reserve the right to swear behind it at a later date. Nevertheless, Applicants submit that the claims are distinguishable over Broerman for at least the reasons argued below.

To anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”¹ It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*”²

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

With respect to claim 1, Applicants submits that the Office Action did not make out a *prima facie* case of anticipation as Broerman does not teach each and every claim element. Applicants fail to find in Broerman any disclosure of “providing the at least one transaction request to the responsible parties having a matched property profile.” Applicants submit that Broerman describes at Col 7 lines 25-44:

“The brokerage system 22 communicates with the property database 20 to make this information available to buyer 13. The *buyer* 13 would access the property information via an electronic request to *search or notify the buyer* 84 of properties matching certain selected criteria to a search engine 86 which queries the property database 20. Advantageously, the search engine 86 may return a listing of appropriate properties so that the *buyer* 13 may select those for which detailed property information is required rather than providing all of the property information without further selection. This specific request would identify a specific property for which the *buyer* 13 is particularly interested.” (Emphasis added).

Broerman teaches providing matched information to the *buyer*; Applicants invention as defined in claim 1 requires providing the transaction request having a matched property profile to the *responsible party* (e.g., the person, group of persons, or entity that is responsible for the renting or sale of the property) and not the *requesting party* (e.g., a prospective renter or purchaser). See paragraph 12 page 4.

With respect to claims 6 and 12, Applicants submit that the Office Action did not make out a *prima facie* case of anticipation as Broerman does not teach each and every claim element.

Applicants fail to find in Broerman any disclosure of “wherein the offer is a rental offer” as recited in claim 6. Broerman deals with buying and selling real property, not renting property. See Col 1 line 10 – Col 2 line 7, Col 2 lines 10-56, Col 3 lines 58-67 and Col 4 lines 13-23.

Applicants fail to find in Broerman any disclosure of “receiving a lease execution notification from at least one of the responsible parties” as recited in claim 12. Again, Applicants submit that Broerman deals with buying and selling real property, not renting property.

With respect to claims 3-10, 12-14, 17-20, 22-25, 27-28, 31-42 and 44-47, which depend on claim 1, Applicants submit that a dependent claim incorporates each of the claim elements of the claim from which it depends. Applicants respectfully submit that claims 1 and 3-10, 12-14, 17-20, 22-25, 27-28, 31-42 and 44-47 are allowable over the cited reference for at least the

reasons stated above and requests the withdrawal of the §102 rejection and allowance of the claims.

§103 Rejection of the Claims

Claims 2, 11, 21, 26 and 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over Broerman in view of Micali (U.S. 5,812,670).

Applicants submit that a dependent claim incorporates each of the claim elements of the independent claim it properly depends from. Applicants assert that Broerman does not teach or suggest³ all of the claim elements of claims 2, 11, 21, 26 and 39 and the combination with Micali does not cure the defect. Therefore, Applicants respectfully request withdrawal of the §103(a) rejection and allowance of claims 2, 11, 21, 26 and 39.

Claims 15-16, 30 and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over Broerman in view of Eggleston et al. (U.S. 6,061,660).

Applicants submit that a dependent claim incorporates each of the claim elements of the independent claim it properly depends from. Applicants assert that Broerman does not teach or suggest all of the claim elements of claims 15-16, 30 and 43 and the combination with Eggleston does not cure the defect. Therefore, Applicants respectfully request withdrawal of the §103(a) rejection and allowance of claims 15-16, 30 and 43.

³ The references when combined must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCOTT S INGRAHAM ET AL.

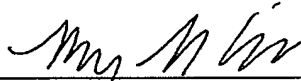
By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
408-278-4042

Date

8/21/06

By



Randy L. Canis
Reg. No. 44,584

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21 day of August, 2006.

Name

Peter Rebovici

Signature

